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Lowell W Gresham
Meschkow & Gresham PLC
Suite 409
5727 North Seventh Street
Phoenix, AZ 85014

EXAMINER	
COLBERT, ELLA	

ART UNIT	PAPER NUMBER
3624	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/613,679	BARRY, GERARD J.	
	Examiner	Art Unit	
	Ella Colbert	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 January 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-8 and 10-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-8 and 10-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 7/06/04
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1, 3-8, and 10-40 are pending in this communication filed 01/03/05 entered as Supplemental Response.

2. The IDS filed 07/06/04 has been considered and entered.

3. The 35 USC 101 Rejection for claims 1-9 still remains for the reason(s) as set forth here below in the "Response to Arguments" section of this Office Action.

Claim Rejections - 35 USC § 101

4. Claims 1, 3-8, 31, 32, and 37-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof". Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See In re Musgrave, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See Diamond v. Diehr, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See State Street Bank & Trust Co. v. Signature Financial Group, Inc. 149 F. 3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed.Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI0. See In re Toma, 197 USPQ (BNA) 852 (CCPA 1978). In Toma, the court held that the cited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to Gottschalk v. Benson, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter ... is statutory, not on whether the product of the claimed subject matter ... is statutory, not on whether the prior art which the claimed subject matter purports to replace ... is statutory, and not whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. In re Toma at 857.

In Toma, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in State Street Bank & Trust Co. v. Signature Financial Group, Inc. never addressed this prong of the test. In State Street Bank & Trust Co., the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result." See State Street Bank & Trust Co. at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under 101, but rather under 102, 103 and 112." See State Street Bank & Trust Co. at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, State Street abolished the Freeman-Walter-Abele test used in Toma. However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in Toma because the invention in State Street (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within

the technological arts under the Toma test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a 101 rejection finding the claimed invention to be non-statutory. See Ex parte Bowman, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, claims 1-9 have no connection to the technological arts. **None of the steps indicate any connection to a computer or technology. The steps of obtaining the card number, identifying an issuer code, determining the operating currency, and setting the currency could be performed manually by a person. Therefore, the claims are directed towards non-statutory subject matter. To overcome this rejection the Examiner recommends that Applicant amend the claims to better clarify which of the steps are performed by a computer or a server.**

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by (WO 95/121169) Lavine et al, hereafter Lavine.

With respect to claim 1, Lavine teaches, A method for determining a preferred currency for association with a payment card transaction, the payment card having a card number, between a merchant and a payment card cardholder comprising the steps of; obtaining the card number of the payment card from the cardholder (page 1, lines

11-16), identifying an issuer code from said card number (page 3, lines 12-27), determining the operating currency for said issuer code (page 5, lines 23-29), and setting the currency for association with the payment card transaction as the determined operating currency for the issuer code (page 5, lines 30-38).

With respect to claim 3, Lavine teaches, A method according to claim 1, wherein the preferred currency is set to default currency of the merchant when no operating currency can be determined for the issuer code (page 9, lines 24-32).

7. Claims 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over (WO 95/12169) Levine et al, hereafter Levine in view of (EP 0251619) Boston.

With respect to claim 4, Lavine failed to teach, wherein the cardholder is prompted as to whether the transaction is to be conducted in the preferred currency, including the steps of converting the transaction amounts to equivalent amounts in the preferred currency and presenting these amounts for review by the cardholder and/or presenting an exchange rate to the cardholder, said exchange rate corresponding to a rate between the merchants' currency and the preferred currency. Boston teaches, wherein the cardholder is prompted as to whether the transaction is to be conducted in the preferred currency, including the steps of converting the transaction amounts to equivalent amounts in the preferred currency and presenting these amounts for review by the cardholder and/or presenting an exchange rate to the cardholder, said exchange rate corresponding to a rate between the merchants' currency and the preferred currency (page 5, paragraphs 3 & 4). It would have been obvious to one having

ordinary skill in the art at the time the invention was made to have wherein the cardholder is prompted as to whether the transaction is to be conducted in the preferred currency, including the steps of converting the transaction amounts to equivalent amounts in the preferred currency and presenting these amounts for review by the cardholder and/or presenting an exchange rate to the cardholder, said exchange rate corresponding to a rate between the merchants' currency and the preferred currency and to modify in Levine because such a modification would allow Levine to have the transaction amount expressed in the foreign currency using the associated conversion rate.

With respect to claim 5, Levine failed to teach, wherein at least one of the transaction amounts is converted to an equivalent amount in the preferred currency and is presented to the cardholder. Boston teaches, wherein at least one of the transaction amounts is converted to an equivalent amount in the preferred currency and is presented to the cardholder (page 5, paragraph 4 and page 6, paragraphs 1 and 2 (display screen). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have wherein at least one of the transaction amounts is converted to an equivalent amount in the preferred currency and is presented to the cardholder and to modify in Levine because such a modification would allow Levine to have the transaction amount expressed in a foreign currency and entered through the data entry means and compared to the converted transaction limit to determine if the transaction should be approved. Page 6, paragraphs 1 and 2 teach a display.

With respect to claim 6, Levine failed to teach, further comprising the step of presenting an exchange rate to the cardholder, said exchange rate corresponding to a rate between the merchants' currency and the preferred currency. Boston teaches, further comprising the step of presenting an exchange rate to the cardholder, said exchange rate corresponding to a rate between the merchants' currency and the preferred currency (page 5, paragraph 4 and page 11, paragraphs 2 and 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the step of presenting an exchange rate to the cardholder, said exchange rate corresponding to a rate between the merchants' currency and the preferred currency and to modify in Levine because such a modification would allow Levine to have the issuer to be supplied with the cardholder's name, account number, and the countries to which the cardholder will be traveling and then the issuer will generate a conversion rate.

With respect to claim 7, Levine failed to teach, wherein the transaction details in the merchants currency are also presented to the cardholder. Boston teaches, wherein the transaction details in the merchant's currency are also presented to the cardholder (page 11, paragraph 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the transaction details in the merchants currency are also presented to the cardholder and to modify in Levine because such a modification would allow Levine to have a favorable rate which is unlikely to be reached in a given time period.

With respect to claim 8, Levine failed to teach, further comprising the step of initially checking to determine if the transaction amount exceeds a predetermined minimum level for processing in an alternative currency to that of the merchants currency. Boston teaches, further comprising the step of initially checking to determine if the transaction amount exceeds a predetermined minimum level for processing in an alternative currency to that of the merchants currency (page 11, paragraphs 3 and 4 and page 12, paragraphs 1-3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the step of initially checking to determine if the transaction amount exceeds a predetermined minimum level for processing in an alternative currency to that of the merchants currency and to modify in Levine because such a modification would allow Levine to have a conversion rate that does not have to be exact since it is not being used to reconcile a transaction and the rate is not used as the basis to transfer funds from the cardholder to the merchant.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by (WO 95/12169) Levine et al, hereafter Levine.

With respect to claim 10, Levine teaches, A data processing system (a data processing system) for determining a preferred currency for association with a payment card transaction, the payment card having a card number, between a merchant and a payment card cardholder, said means comprising; means for obtaining the card number of the payment card from the cardholder (page 1, lines 11-16), means for identifying an issuer code from said card number (page 3, lines 12-27), means for determining the operating currency for said issuer code (page 5, lines 23-29); and means for setting the currency for association with the payment card transaction as the determined operating currency for the issuer code (page 5, lines 30-38).

With respect to claim 11, Levine teaches, A data processing system according to claim 10, wherein said means for determining the operating currency for said issuer code comprises means for comparing said issuer identifier code with entries in a table (page 7, lines 14-33), wherein each entry in the table contains an issuer code or range of issuer codes and a corresponding currency code (page 9, lines 19-23).

With respect to claim 12, Levine teaches, A data processing system according to claim 10, further comprising means for setting the preferred currency to the default currency of the merchant when no operating currency can be determined for the issuer code (page 9, lines 24-32).

10. Claims 13-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over (WO 95/12169) Levine et al, hereafter Levine in view of (EP 0251619) Boston.

With respect to claim 13, Lavine failed to teach, further comprising prompting means for prompting the cardholder as to whether the transaction is to be conducted in the preferred currency, said prompting means optionally comprising conversion means for converting the transaction amounts to equivalent amounts in the preferred currency and presenting these amounts for review by the cardholder and/or means for presenting an exchange rate to the cardholder, said exchange rate corresponding to a rate between the merchants' currency and the preferred currency. Boston teaches, further comprising prompting means for prompting the cardholder as to whether the transaction is to be conducted in the preferred currency (page 7, lines 14-33), said prompting means optionally comprising conversion means for converting the transaction amounts to equivalent amounts in the preferred currency and presenting these amounts for review by the cardholder and/or means for presenting an exchange rate to the cardholder, said exchange rate corresponding to a rate between the merchants' currency and the preferred currency (page 9, lines 19-23). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a prompting means for prompting cardholder as to whether the transaction is to be conducted in the preferred currency, said prompting mean optionally comprising conversion means for converting the transaction amounts to equivalent amounts in the preferred currency and presenting these amounts for review by the cardholder and/or presenting an exchange rate to the cardholder, said exchange rate corresponding to a rate between the merchants' currency and the preferred currency and to modify in

Levine because such a modification would allow Levine to have the transaction amount expressed in the foreign currency using the associated conversion rate.

With respect to claim 14, Lavine teaches, further comprising means for to accepting an indication from the cardholder as to whether the transaction is to proceed in the preferred currency and means for permitting the transaction to be processed in the preferred currency if such an indication is received (page 7, lines 11-21 and lines 22-33).

With respect to claim 15, Lavine failed to teach, further comprising conversion means for converting at least one of the transaction amounts to an equivalent amount in the preferred currency and presenting this converted amount to the cardholder, optionally comprising means for presenting an exchange rate to the cardholder, said exchange rate corresponding to a rate between the merchants' currency and the preferred currency. Boston teaches, further comprising conversion means for converting at least one of the transaction amounts to an equivalent amount in the preferred currency and presenting this converted amount to the cardholder, optionally comprising means for presenting an exchange rate to the cardholder, said exchange rate corresponding to a rate between the merchants' currency and the preferred currency (page 5, paragraphs 3 and 4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a conversion means for converting at least one of the transaction amounts to an equivalent amount in the preferred currency and presenting this converted amount to the cardholder, optionally comprising means for presenting an exchange rate to the cardholder, said exchange

rate corresponding to a rate between the merchants' currency and the preferred currency and to modify in Levine because such a modification would allow Levine to have the issuer to be supplied with the cardholder's name, account number, and the countries to which the cardholder will be traveling and then the issuer will generate a conversion rate.

With respect to claim 16, Lavine failed to teach, further comprising means for initially checking to determine if the transaction amount exceeds a predetermined minimum level for processing in an alternative currency to that of the merchants currency. Boston teaches, further comprising means for initially checking to determine if the transaction amount exceeds a predetermined minimum level for processing in an alternative currency to that of the merchants currency (page 11, paragraphs 3 and 4 and page 12, paragraphs 1-3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a means for initially checking to determine if the transaction amount exceeds a predetermined minimum level for processing in an alternative currency to that of the merchants currency and to modify in Levine because such a modification would allow Levine to have a conversion rate that does not have to be exact since it is not being used to reconcile a transaction and the rate is not used as the basis to transfer funds from the cardholder to the merchant.

With respect to claim 17, Lavine teaches, wherein said data processing system is embodied in a payment card terminal (page 9, lines 24-37, page 10, lines 30-37, and page 11, lines 1-12).

With respect to claim 18, Lavine teaches, wherein said data processing system is embodied in a central payment router (Fig. 3, element 43, element 50, and element 51).

With respect to claim 19, Lavine teaches, wherein said data processing system is embodied in an authorisation host, optionally in co-operation with another system.(page 8, lines 16-35).

With respect to claim 20, Levine teaches, wherein said other system is a payment card terminal or central payment router (Fig. 3 (central payment router link 43, network 51, and ATM 50).

With respect to claim 21, Lavine teaches, further comprising means for connecting to a node in a computer network (page 8, lines 16-19).

With respect to claim 22, Lavine teaches, wherein the card number is received via the computer network (page 4, lines 11-18).

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by (WO 95/121169) Levine et al, hereafter Levine.

With respect to claim 23, Levine failed to teach, A computer program encoding a set of computer instructions for use in a computing device. It would have been inherent to the computer system to have a computer program encoding a set of computer instructions for use in a computing device since a computer program is a set of instruction for telling a computer what to do and the encoding is merely a means of producing a unique combination of bits (a code) in response to an analog input signal.

This independent claim is rejected for the similar rationale given above for claims 1 and 10.

With respect to claim 24, this dependent claim is rejected for the similar rationale as given above for claims 2 and 11.

With respect to claim 25, this dependent claim is rejected for the similar rationale as given above for claims 3 and 12.

13. Claims 26-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over (WO 95/12169) Levine et al, hereafter Levine in view of (EP 0251619) Boston.

With respect to claim 26, this dependent claim is rejected for the similar rationale as given above for claims 4 and 13. A computer program encoding a set of computer instructions for use in a computing device has been addressed above in independent claim 23.

With respect to claim 27, this dependent claim is rejected for the similar rationale given above for claim 5.

With respect to claim 28, this dependent claim is rejected for the similar rationale given above for claims 6 and 15.

With respect to claim 29, this dependent claim is rejected for the similar rationale given above for claim 7.

With respect to claim 30, this dependent claim is rejected for the similar rationale given above for claim 8.

With respect to claim 31, Lavine teaches, A method according to claim 1, wherein the card holder is prompted as to whether the transaction is to be conducted in the preferred currency, including the steps of converting the transaction amounts to equivalent amounts in the preferred currency and presenting an exchange rate to the cardholder, said exchange rate corresponding to a rate between the merchant's currency and the preferred currency (page 11, line 3- page 12, line 4).

With respect to claim 32, this dependent claim is rejected for the similar rationale as above for claim 31.

With respect to claim 33, this dependent claim is rejected for the similar rationale as given above for claims 31 and 32.

With respect to claim 34, this dependent claim is rejected for the similar rationale as given above for claims 31-33.

With respect to claim 35, Lavine teaches, A computer program according to claim 23, having a computer code section which when executed on the computing device prompts the card holder as to whether the transaction to be conducted in the preferred currency, including presenting an exchange rate to the cardholder, said exchange rate

corresponding to a rate between the merchant's currency and the preferred currency (page 6, lines 20-34 and page 7, lines 2-33). This dependent claim is also rejected for the similar rationale as given above for claims 31-34.

With respect to claim 36, this dependent claim is rejected for the similar rationale as given above for claims 34 and 35.

With respect to claim 37, Lavine teaches, A method of operating a data processing system to conduct a financial transaction for the exchange of money provided by a payment card cardholder for a good or service provided by a merchant, said method comprising: obtaining a card number from said payment card (page 3, lines 12-27); identifying an identifier code from said card number (page 3, lines 1-11 and lines 28-34). Lavine failed to teach, determining an operating currency for said identifier code by comparing said identifier code with entries in a table that associates issuer codes with currency codes; indicating said operating currency as being a preferred currency of exchange for said financial transaction; receiving a cardholder reply in response to said indicating activity; and completing said financial transaction in response to said receiving activity. Boston teaches, determining an operating currency for said identifier code by comparing said identifier code with entries in a table that associates issuer codes with currency codes (page 5, paragraph 4 and page 10, paragraph 3 –page 11, paragraph 3); indicating said operating currency as being a preferred currency of exchange for said financial transaction (page 12, paragraphs 2- 4); receiving a cardholder reply in response to said indicating activity (page 15, paragraph 2 – page 16, paragraph 2); and completing said financial transaction in response to said receiving

activity (Page 16, paragraph 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to determine an operating currency for said identifier code by comparing said identifier code with entries in a table that associates issuer codes with currency codes; indicate said operating currency as being a preferred currency of exchange for said financial transaction; receive a cardholder reply in response to said indicating activity; and complete said financial transaction in response to said receiving activity and to modify in Lavine because such a modification would allow Lavine's system to compare the transaction amount that has been entered with the amount of the transaction expressed in the foreign currency.

With respect to claim 38, Lavine failed to teach, A method as claimed in claim 37 wherein: said cardholder reply instructs said data processing system to conduct said financial transaction using said preferred currency; and said completing activity completes said financial transaction using said preferred currency. Boston teaches, A method as claimed in claim 37 wherein: said cardholder reply instructs said data processing system to conduct said financial transaction using said preferred currency (page 12, paragraph 3 –page 15, paragraph 1); and said completing activity completes said financial transaction using said preferred currency (page 15, paragraph 2 –page 16, paragraph 3). It would it have been obvious to one having ordinary skill in the art at the time the invention was made to have the cardholder reply instructs said data processing system to conduct said financial transaction using said preferred currency; and said completing activity completes said financial transaction using said preferred currency and to modify in Lavine because such a modification would allow Lavine's

system to have an approval given and an authorization code to be generated for the transaction amount.

With respect to claim 39, Lavine failed to teach, A method as claimed in claim 38 wherein: said indicating activity additionally indicates a currency exchange rate for converting from a merchant currency to said preferred currency; and said completing activity uses said currency exchange rate in completing said financial transaction. Boston teaches, the indicating activity additionally indicates a currency exchange rate for converting from a merchant currency to said preferred currency (page 14, paragraph 2- page 15, paragraph 3); and said completing activity uses said currency exchange rate in completing said financial transaction Page 15, paragraph 4- page16, paragraph 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the indicating activity additionally indicates a currency exchange rate for converting from a merchant currency to said preferred currency; and said completing activity uses said currency exchange rate in completing said financial transaction and to modify in Lavine because such a modification in Lavine's system would allow Lavine to allow the cardholder to enter an amount of the transaction in the currency selected and to convert from a merchant currency to the customer's preferred currency.

With respect to claim 40, Lavine failed to teach, A method as claimed in claim 38 wherein said indicating activity additionally indicates a first amount of money for said financial transaction using a merchant currency and a second amount of money for said financial transaction using said preferred currency. Boston teaches, wherein said

indicating activity additionally indicates a first amount of money for said financial transaction using a merchant currency and a second amount of money for said financial transaction using said preferred currency (page 10, paragraph 3- page 11, paragraph 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the indicating activity additionally indicates a first amount of money for said financial transaction using a merchant currency and a second amount of money for said financial transaction using said preferred currency and to modify in Lavine because such a modification would allow Lavine's system to have the transaction converted from the base currency in one amount and converted to the selected foreign currency in that foreign currencies amount.

Response to arguments

14. Applicant's arguments filed 07/06/04 and 01/03/05 have been fully considered but they are not persuasive.

Issue no. 1: Applicant argues: the 35 USC 101 Rejection of independent claims 1 and 37 and dependent claims 3-8, 31, 32, 38-40 as being in the technological arts. Response: Independent claims 1 and 37 and dependent claims 3-8, 31, 32, and 38-40 that depend there from are rejected under 35 USC 101 as non-statutory because the method claims as presented do not claim a technological basis in the body of the claim. Without a claimed basis in independent claims 1 and 37, the claim may interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 USC 101. In contrast, **a method claim that includes in the body of the claim at least one structural/functional interrelationship which can**

only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (BD. Pat. App. & Inter. 2001) –used only for content and reasoning since not precedential].

The independent claims fail to have a computer or device performing the method steps that follow.

Issue no. 2: Applicant argues: claim 10 recites "means for setting the currency for association with the payment card transaction as the determined operating currency for the issuer code" and this transaction-currency- setting feature is neither disclosed not suggested by Levine, either alone or in combination with the other prior art of record has been considered but is not persuasive. Response: It is interpreted that Levine teaches a means for setting the currency for association with the payment card transaction as the determined operating currency for the issuer code on page 5, lines 30-38 and Boston teaches, a means for setting the currency for association with the payment card transaction as the determined operating currency for the issuer code on page 11, paragraph 2 ("... the transaction card is provided with one or more rates for converting the base currency into different foreign currencies. The cardholder can then select the desired currency from the data input means. The microprocessor converts the transaction limit from the base currency to the selected foreign currency. When the transaction amount is entered, it can be directly compared with the converted transaction amount to permit the generation of an approval code").

Issue no. 3: Applicant argues: claim 23 recites "a computer code section which when executed on the computing device sets the currency for association with the

payment card transaction as the determined operating currency for the issuer code" and this transaction-currency-setting feature is neither disclosed or suggested by Levine, either alone or in combination with the other prior art of record. Response: It is inherent for a computer program to encode a set of computer instructions for use in a computing device since a computer program is a set of instructions for telling a computer what to do and the encoding is merely a means of producing a unique combination of bits (a code) in response to an analog input signal which is well known in the computer art. Claims 23 and newly added claim 37 is discussed above in the response of Issue no. 2.

Conclusion: The Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the Specification (see below):

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969). The court determined that to read a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim. "The court found that applicant was advocating the latter, e.g., the impermissible importation of subject matter from the specification into the claim.).<

Applicants' are respectfully requested to point out to the Examiner and to distinctly claim that which is considered to be the inventive concept in the claims and in the claim language.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiries

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

E. Colbert
April 14, 2005